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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/561,494

05/16/2006

Jeffrey Bruce McGeorge

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EXAMINER

THOMPSON, MICHAEL M

ART UNIT

PAPER NUMBER

3629

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/561,494	<b>Applicant(s)</b> MCGEORGE, JEFFREY BRUCE	
	<b>Examiner</b> Michael M. Thompson	<b>Art Unit</b> 3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In the claims, several terms such as “real-time wagering data”, “user specifying analysis criteria”, “nominated change”, “a wagering parameter”, “a nominated time period”, and “nominated wagering parameter”, appear to lack support in the specification. With respect to the “real-time wagering data”, “user specifying analysis criteria”, “nominated change”, “a wagering parameter”, “a nominated time period”, and “nominated wagering parameter” primarily in claim 1, 37 CFR 1.75(d)(1) provides, in part, that “the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” Please note that Applicant should evaluate the claims for additional terms not found in the specification. No new matter should be added.

### ***Claim Rejections - 35 USC § 112 – Second Paragraph***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 recites the limitation "the nominated wagering parameter" in section e.

There is insufficient antecedent basis for this limitation in the claim.

5. Claim 1 recites the limitation "a remote communications device" twice in section e. It is unclear if Applicant intends for there to be two separate RCD devices.

6. Claim 5 recites the limitation "the principal" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 112 – First Paragraph***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-8 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims contain newly introduced language referring to elements such as, but not limited to, "real-time wagering data", "user specifying analysis criteria", "nominated change", "a wagering parameter", "a nominated time period", and "nominated wagering parameter", appear to lack support in the specification. With respect to the "real-time wagering data", "user specifying analysis criteria", "nominated change", "a wagering parameter", "a nominated time period", and "nominated wagering parameter" which appear to introduce or cover new matter and may encompass broader or more narrow subject matter not in possession at

the time of the invention. For example, it appears that the term “wagering data” might include other forms of data not originally envisioned by applicants claimed invention. In the least these other forms are clearly not supported. Similarly, the specification is void with much discussion on parameters and appears to have only discussed this with respect to credit usage data and not to “wagering data” or “wagering parameters.” In fact, it appears that the only supported “parameters” are related to credit card agency data.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. **Claims 1-8 and 10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define “things” or “products”, while a “process” consists of a series of steps or acts to be performed. For purposes of 101, the analysis of a process is guided by the machine-or-transformation test. *In re Bilski*, \_\_\_ F.3d \_\_\_ (Fed. Cir. 2008)(en banc).

Based on Supreme Court precedent (*Diamond v Diehr*, 450 U.S. 175,184 (1981); *Parker v. Flook*, 437 US 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent precedent from

the Federal Circuit from *In re Bilski*, the machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See *Benson*, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by *Benson*, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Benson*, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590. If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 U.S.C. 101.

**Claims 1-8 and 10** are drawn to **a method of monitoring changes in an information set of wagers**. All of the recited method steps can be performed by the user themselves, in the mind of the user or between different users through writing by a user, and therefor these method steps are not tied to a particular machine nor do they transform an article. For example, a human service provider could receive instructions from the user and apply the user-specified analysis criteria. The human service provider could also call the user to provide the alert message for changes in wagering data. With respect to the receiving real-time wagering data on a network of computers, the data received on the network could merely be displayed data to the human service provider. This displayed data is considered extra post solution activity. To qualify as a statutory process, the claim should positively recite in the body of the claim, the

machine to which it is tied. For example, by identifying the machine that accomplishes the method steps, or positively reciting the article that is being transformed.

Please note that ***nominal recitations of a machine in an otherwise ineligible method fail to make the method a statutory process***. See Benson, 409 U.S. at 70 - 72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). Incidental physical limitations, such as data gathering, field of use limitations, storing, collecting, sending, receiving, and other forms of insignificant extra solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of involvement of a machine or transformation in a method claim do not convert an otherwise ineligible claim into an eligible one. *Ex parte Langemyr* (2008) and *In re Bilski*, (Fed. Cir. 2008).

Therefore, the applicable test to determine whether a claim is drawn to a patent-eligible process under § 101 is the machine-or-transformation test set forth by the Supreme Court and clarified herein, and Applicants' claim here appears to fail this test. No new matter should be added.

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. **Claims 1-8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ginsberg et al. (US 2002/00099648).**

13. **With respect to claim 1**, Ginsberg et al. teaches a method of monitoring changes in an information set of wagers placed (i.e. real –time interactive wagering Para. 0028) on the outcome of a sporting contest (i.e. Abstract), the method comprising the steps of: entering into an agreement with a service provider to provide real time monitoring service of changes in an information set of wagers placed on the outcome of a sporting contest (i.e. Para. 0031 for the client relationship to acquire services); receiving real-time wagering data relating to the outcome of a sporting contest on a network of computers ( i.e. Para. [0028-0030 and 0053]); receiving instructions from a user specifying analysis criteria including at least a target sporting contest, and nominated change in a wagering parameter within a nominated time period prior to the commencement of the target sporting contest which signifies the occurrence of a change in the wagering data significant to the user; applying the user-specified analysis criteria to the real-time wagering data in real-time; and causing a real-time alert message to be provided to the user via a remote communications device (RCD) upon the occurrence of the change in the nominated wagering parameter within the nominated time period prior to the commencement of the target sporting contest as real-time changes in the wagering data occur, the real-time notification directed to a remote communications device of the user. (i.e. Para. 0062 and claim 41 for the proposition that warnings can be set or presented and 0029 for the deliverable RCD's)



14. **With respect to claim 2**, Ginsberg et al. teaches all of the limitations of claim 1, including the service provider utilising a “totalisator agency database” to monitor the wagering data (i.e. 0030 or 0053).

15. **With respect to claim 3**, Ginsberg et al. teaches all of the limitations of claim 1, including the remote communications device (RCD) comprises the user's fixed or mobile telephone, a personal computing device or a facsimile or pager of the user (i.e. Para. 0020 or 0029).

16. **With respect to claim 4**, Ginsberg et al. teaches all of the limitations of claim 1, including the inherent teaching of a user having an RCD that has a software component (i.e. such as any web interface Para. 0020) which can be used to send an input command to a software environment that is running on the network of computer systems of the service provider (i.e. Para. 0020 when the user/client/principal interacts via the web) in response to the input command the software environment sends a local input command to a software environment component that processes the command (i.e. the operating systems and wagering software application of the company described in the prior art) and which responds by issuing a local output command to a server infrastructure which in turn sends a remote output command to the user's RCD (i.e. similarly inherent in computer transmission facilitated in the prior art), and in response to a remote output commands, the RCD issues or displays an alert output (i.e. error message displayed on the computer terminal, etc., i.e. Para. 0062 for alert output).

17. **With respect to claim 5**, Ginsberg et al. teaches all of the limitations of claim 1, including the principal can define parameters of a situation in which alert messages are to be issued (i.e. Para. 0062 for entering instructions for alert messages).

18. **With respect to claim 6**, Ginsberg et al. teaches all of the limitations of claim 1, including the service provider using a network of computers or computer systems to monitor the wagering data (i.e. Para. 0028-0029 and 0066-0067 or claim 51).

19. **With respect to claim 7**, Ginsberg et al. teaches all of the limitations of claims 1 and 5, including the network of computers adapted to send and receive information to and from a totalisator agency data server which contains real time information regarding the wagering data. (i.e. Para. 0067 or claim 51). Please note that networks are inherently capable or adaptable to allow for sending and receiving information to all types of servers. MPEP 2111.04 for the proposition that claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure.

20. **With respect to claim 8**, Ginsberg et al. teaches all of the limitations of claim 1, further comprising the step of providing at least one history server, the purpose of which is to provide data to any of the computers, the history server scanning all of the transaction data as it becomes available so that the data never needs to be requested from an outside source more than once, the history server storing the wagering data in a database to prevent the need to request the same information numerous times. ((i.e. 0051-0053 or 0066-0067 or claim 51)

21. **With respect to claim 10**, Ginsberg et al. teaches all of the limitations of claims 1 and 8, including the user communicating to the service provider at least one analysis criteria upon which alerts are to be sent. (i.e. Para. 0062 for entering instructions for alert messages).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-8 and 10 have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments have been fully considered but they are not persuasive.

22. In the arguments Applicant states, "[a]ccording to claim 1, instructions are received from a user, specifying analysis criteria including at least a target sporting contest, and a nominated change in a wagering parameter within a nominated time period prior to the commencement of the target sporting contest which signifies the occurrence of a change in the wagering data significant to the user." Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant's arguments attempt to distinguish the invention over the prior art by claiming the invention is not a system for making online wagers. Furthermore, the fact that Ginsberg et al. teaches additional processes or steps does not distinguish Applicant's invention over the prior art, specifically when Applicant's limitations include the term "comprising."

23. Applicant's primary argument to distinguish his invention argues, "Ginsberg does not teach receiving instructions from a user specifying analysis criteria including at least a target sporting contest, and nominated change in a wagering parameter within a nominated time period prior to the commencement of the target sporting contest. For this reason, claim 1 is not anticipated by Ginsberg." It should be noted that several of the terms do not appear to find support in the specification and further raise issues of new matter. However, the Examiner has interpreted these limitations to indicate a user who is able to set some limitations, parameters, or rules that are observed for some change. When a change occurs the applicant is notified of the change. The previous rejection of the claims indicated paragraph [0062] for the proposition that warnings can be set or presented and [0029] for the deliverable RCD's. Furthermore, claim 41 stands for the proposition that the user can set parameters in which they will be notified. These paragraphs and claim 41 support the proposition that an alert can be sent prior to commencement of the sporting contest since a user is likely to bet prior to closing of the bet.

Applicant further states, "[t]he method of claim 1 enables the setting of criteria to generate an alert so that the user can be alerted to the occurrence of an event which signifies that educated wagerers have entered the wagering market and are wagering on a particular competitor within the sporting contest. This will allow a user to take advantage of the changes in the wagering data based on the educated users rather than the masses, and thereby gain advantage over the masses. This advantage is a direct consequence of the method of claim 1 and is not taught, nor suggested in

Ginsberg.” In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., features represented in statement supra) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is believed that the Examiner has addressed Applicant's arguments with respect to the supposed deficiencies of the previous rejection and prior art over the newly amended claims.

### ***Conclusion***

24. The Examiner has pointed out particular references contained in the prior art of record, within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. NPL of the website [www.youbet.com](http://www.youbet.com) more than a year earlier of applicants effective filing date reciting a betting website providing several of the services claimed. Please note that several other references originally recited in the PCT search report may also be applicable.

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael M. Thompson whose telephone number is (571) 270-3605. The examiner can normally be reached on Monday thru Friday 8am-5:30 except Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M Thompson/  
Examiner, Art Unit 3629

/Jamisue A. Plucinski/  
Primary Examiner, Art Unit 3629